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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/778,052

02/06/2001

Thomas Steinhausler

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(8A04-BD-1-1)

6217

7590

06/11/2003

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,052

Applicant(s)

STEINHAUSLER ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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The claims of co-pending application '402 discloses molding composition comprising modified unsaturated curable polyester, monomer that is reactive with polyester, thermoplastic polymer filler and reinforcing filler.

The monomers include methyl methacrylate. The polymers include styrene polymers. Fillers include alumina trihydrate, alumina powder, aluminosilicate, glass spheres, mica, silica and the like.

The difference between the present invention and the disclosure of the co-pending '402 is recitation that the polyester is modified and explicit recitation of pigment.

With respect to the recitation of the modified polyester, the present invention is broad and it encompasses regular unsaturated polyester as well as one that is modified.

With respect to the recitation of pigment, which is aesthetic type filler, although not taught, many of the fillers will naturally provide color to the composition. For example, alumina is white. One of ordinary skill in the art would know that.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art that when practicing claims of co-pending '402 one would arrive at the invention at hand.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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In view of the applicant's filing of co-pending application 10/268402 following office action is non-final containing additional double patenting rejection.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,2, 7-16, 22-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12-18 of copending Application No. 10/268402 (402). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 6-14, 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Heel (US 5,094,797).

The discussion of the disclosure of the prior art of Heel from paragraph 3 of the office action mailed on 5/22/2002 is incorporated here by reference.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 4, 5, 15, 16, 23, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heel (US 5,094,797)

Discussion of the disclosure of the prior art of Heel from paragraph 7 of the office action mailed on 5/22/2002 is incorporated here by reference.

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In the response filed on May 21, 2003 the applicant has provided an Affidavit of Dr. Friedrich Goffing, one of the co-inventors of the prior art of Heel applied against present claims.

The examiner appreciates Mr. Goffing's time to provide the affidavit, however, the affidavit does not overcome the prior art of Heel. In the affidavit, Mr. Goffing stated that the purpose of the inventors of the prior art of record was to arrive at simple, inexpensive process of preparing homogeneously pigmented curable composition and that the weatherability was not objective of the work. The statement of Mr. Goffing is insufficient, since it does not state if the composition of Heel is actually weatherable or not. Just because certain goal was not an objective of research it does not automatically mean that it had not been obtained.

The applicant's arguments in the response also rely on Mr. Goffing's declaration, therefore examiner's position that the weatherability of the composition would be an inherent property has not been overcome.

Also for the record, the amendment after final filed by the applicant on May 21, 2003 has been entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KIWL
June 10, 2003

EDWARD J. CAIN
PRIMARY EXAMINER
GROUP 1500

